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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/486,677	06/26/2000	ANSGAR BEHLER	H-2938-PCT/U	8906

23657 7590 09/03/2002

COGNIS CORPORATION  
2500 RENAISSANCE BLVD., SUITE 200  
GULPH MILLS, PA 19406

EXAMINER

KEYS, ROSALYND ANN

ART UNIT	PAPER NUMBER
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1621

DATE MAILED: 09/03/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/486,677

**Applicant(s)**

BEHLER ET AL.

**Examiner**

Rosalynd Keys

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 10, 14-26 and 30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10, 14-26 and 30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Status of Claims***

1. Claims 10, 14-26 and 30 are pending.

Claims 10, 14-26 and 30 are rejected.

### ***Reopening of Prosecution After Appeal***

2. In view of the appeal brief filed on March 26, 2002, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

3. **Note:** the rejection that appears below is essentially the same rejection as presented in the final rejection of June 13, 2001. Prosecution is being reopened only in order to apply a reference to show that it is known to use surfactants with agrochemicals and pesticides.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 10, 14-26 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over GB 1,172,931 in view of Naik et al. (US 4,731,378) or Grossmann et al. (US 4,999,041).

GB 1,172,931 teaches nonionic surface active agents (surfactants) having a random mixture of oxypropylene and oxyethylene groups (see page 2, lines 15-35, 75-80 and 105-123; page 3, lines 2-38; and Examples IV and V).

GB 1,172,931 fail to teach the ranges of EO and PO disclosed in the instant claims. However, on page 3, lines 20-22 GB '931 teaches a weight ratio of propylene oxide to ethylene oxide ranges from 0.85:1 to 2.75:1. In the instant application the weight ratio of propylene oxide to ethylene oxide ranges from 0.4:1 to 0.83:1. The

weight ratios of GB 1,172,931 and the instant invention are close enough that one having ordinary skill in the art would have expected them to produce the same results. Further, it is well established that merely selecting proportions and ranges is not patentable absent a showing of criticality. *In re Becket*, 33 U.S.P.Q. 33 (C.C.P.A. 1937). *In re Russell*, 439 F.2d 1228, 169 U.S.P.Q. 426 (C.C.P.A. 1971).

GB 1,172,931 fails to teach the use of surfactants with agrochemicals and pesticides.

Naik et al. teach the use of surfactants in a pesticide formulation (see entire disclosure, in particular column 1, line 49 to column 2, line 65).

Grossman et al. teach the use of surfactants with a herbicide (see entire document, in particular column 3, line 31 to column 4, line 36).

One having ordinary skill in the art at the time the invention was made would have found the use of the nonionic surfactants of GB 1,172,931 in combination with agrochemicals and pesticides obvious, since Naik et al. and Grossmann et al. teach that the use of surfactants allow the skilled artisan to formulate the pesticides and herbicides into sprays, emulsions, solutions, etc. One having ordinary skill in the art would be motivated to make such formulations for ease of treatment of plants.

7. Claims 10, 14-26 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tominaga et al. (JP 7-303825) in view of Naik et al. (US 4,731,378) or Grossmann et al. (US 4,999,041).

Tominaga et al. disclose a nonionic surfactant with good fluidity at low temperatures and an excellent cleaning performance. These nonionic surfactants are obtained by random addition of, on an average, 5-15 moles of ethylene oxide and 0.3-5.0 moles of propylene oxide (see claim 1, pages 2-4 and Table 1).

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Tominaga et al. do not exemplify the claimed ranges of EO and PO. However, it is well established that consideration of a reference is not limited to the preferred embodiments or working examples, but extends to the entire disclosure for what it fairly teaches to a person of ordinary skill in the art. *In re Boe*, 355 F.2d 961, 148 USPQ 507 (CCPA 1966); *In re Lamberti*, 545 F.2d 747, 750, 192 USPQ 279, 280 (CCPA 1976); *In re Fracalossi*, 681 F.2d 792, 794, 215 USPQ 569, 570 (CCPA 1982); *In re Kaslow*, 707 F.2d 1366, 1374, 217 USPQ 1089, 1095 (Fed. Cir. 1983). The EO and PO ranges disclosed in the specification of Tominaga et al. overlap with the claimed EO and PO ranges. In the instant application the EO value ranges from about 3 to about 5 and the PO value ranges from about 2 to about 2.5. Tominaga et al. teach using 5-15 moles of EO and 0.3 to 5 moles of PO. It has been held that in the case where claimed ranges "overlap or lie inside ranges disclosed by the prior art" a prima facie case of obviousness exists. *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); *In re Woodruff*, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990); *In re Geisler*, 116 F.3d 1465, 1469-71, 43 USPQ2d 1362, 1365-66 (Fed. Cir. 1997).

Tominaga et al. fail to teach the use of surfactants with agrochemicals and pesticides.

Naik et al. teach the use of surfactants in a pesticide formulation (see entire disclosure, in particular column 1, line 49 to column 2, line 65).

Grossman et al. teach the use of surfactants with a herbicide (see entire document, in particular column 3, line 31 to column 4, line 36).

One having ordinary skill in the art at the time the invention was made would have found the use of the nonionic surfactants of Tominaga et al. in combination with agrochemicals and pesticides obvious, since Naik et al. and Grossmann et al. teach that the use of surfactants allow the skilled artisan to formulate the pesticides and herbicides

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into sprays, emulsions, solutions, etc. One having ordinary skill in the art would be motivated to make such formulations for ease of treatment of plants.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rosalynd Keys whose telephone number is 703-308-4633. The examiner can normally be reached on M and F 3:00-8:00 pm and T-R 5:30-10:30 am.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 703-308-4532. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

*R. Keys*  
R. Keys  
August 28, 2002

*Rosalynd Keys*  
Rosalynd Keys  
Primary Examiner  
Art Unit 1621